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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,428	12/03/2001	Stephen M. Key	PA2321	1741
22830	7590	03/31/2005	EXAMINER	
CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,428

Applicant(s)

KEY, STEPHEN M.

Examiner

Daniel Zirker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-35 and 39-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-26, 32-35, 39-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 24-26, 32-35, and 41-52 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, upon careful inspection applicant's claims appear to be quite vague, indefinite and confusing with respect to what is in many instances very brief and indefinite claim language defining the various elements of the labels, adhesive layers and the like. The Examiner will attempt to point out as many as possible but others may be inadvertently overlooked and applicant is urged to carefully correct these elements. For example, in claim 24, the Examiner finds applicant's recitation of the outer layer to be somewhat incomplete in that it recites only "first and second edges" (but no third and fourth edges) and it is also confusing that the first edge is generally ignored while the second edge (which is nowhere else defined with respect to its specific location) has an adhesive layer "adjacent to the second edge on the back surface". Additionally, the "first adhesive" is only defined as being "on the back surface" and the Examiner makes the general observation that these various elements in claim 24 as well as elsewhere in the claims, particularly applicant's

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independent claims 32 and 46 should be significantly amended so as to more definitively define these various claimed elements. In claim 25 and elsewhere, the Examiner believes that the "slip agent" is disposed in the adhesive composition, not as set forth by applicant where it exists independently by itself. In claim 26 the Examiner believes that applicant's recitation of the viscosity parameter is incorrect. In claim 32 the phrase "first adhesive disposed on a front surface of the inner label" is found confusing in that the only other recitation to the "inner label front surface" is in the next line and the phrase, i.e. lines 6-8 of claim 32 is believed vague and indefinite. In this claim as well, the "first edge" seems to have been totally forgotten since the adhesives are mentioned in certain locations only with respect to positioning to the second edge. In claim 33 the phrase "written indicia is disposed on the inner label" makes no indication of what surface of the inner label the indicia is located thereon. In claim 36 there is again only the briefest reference to an inner label (lines 5-6) and claim 46 is also believed to be in many of its phrases and various relationships vague and indefinite with respect to its specific elements. Additionally, applicant's earlier remarks about the slip agent as set forth in claim 50 are also repeated.

3. Claims 24-26, 32-35 and 41-52 are rejected under 35

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U.S.C. § 103(a) as being unpatentable over Barnum, Jr., taken in view of either Haines or Ingle, substantially for reasons of record, particularly as set forth in paragraph No. 5 of Paper No. 032304, together with the following additional observations. To somewhat reiterate, Barnum, Jr. is again relied upon as disclosing a container having an inner label glued or pasted to the container and on the inner label's outer surface an outer label 21 which can be both transparent and also rotatable so as to be capable of viewing the pictures or other printed literature set forth on the outer surface of the inner label. The reference fails to disclose what are believed to be the relatively conventional bonding arrangements found in applicant's claims, but such claims essentially require only a suitable backing layer coated with either one or two types of adhesive, which is believed to be clearly disclosed by each of the secondary references, which are again relied upon substantially as set forth in paragraph No. 7 of Paper No. 0909 except for the fact that these labels are not rotatable. However, they clearly teach the relied upon adhesive bonding patterns which have more than one sort of adhesive bonding section, and which the Examiner believes that one of ordinary skill in the art is more than capable of designing to fit the required bonding characteristics, including the ability to both break a desired bond at a certain

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time so as to enable the outer label to rotate about the inner label or container, as well as also to be able to reaffix to the other label if this is so desired. Applicant argues that the relied upon combinations fail to teach a temporary "coupling" and subsequent removal of the "coupling" to provide for rotation of the outer label, but the Examiner repeats his contention that temporary coupling is believed to be well within the skill of the art in view of the relied upon combinations, i.e. note Haines at Col 3, lines 43-45 for a teaching that a wide variety of adhesives may be used. Additionally, the motivation to use such adhesives is believed to be a parameter clearly within the ordinary skill of the art in view of the artisan's desire to be able to control the outer label both during rotation and also afterwards; i.e. to be able to both detach and then reaffix the outer label to the inner label or container if so desired is believed to be a parameter well within the ordinary skill of the art having clearly desirable properties. Additionally, it is again noted that claim 24 does not require the presence of an inner label or container, and that claim 32 essentially requires only the presence of both outer and inner layers, but does not require either label to be in any sort of bonding relationship, i.e. it essentially appears to be a label kit, and it also appears that independent claim 46 which does require the presence

of a container could be characterized as a label kit having included among its components a container. Other parameters that are not either expressly or inherently disclosed such as the presence of slip agents, or adhesives of a certain viscosity are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

March 29, 2005

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1500-
1700

Daniel Zinker